

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 15-18, 20-25 and 28-32 are pending in this application. No amendments have been made to the claims. The response below is similar to the arguments presented in the Appeal Brief on 12 March 2007, but also includes a passage which addresses the recent U.S. Supreme Court decision *KSR International v. Teleflex. Inc.*

Note: A 3-month suspension of action is also being filed concurrently with this response.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 16-18, 21, 23, 25, 28 and 30-32 were rejected as allegedly being obvious under 35 U.S.C. §103(a) by Pappas-Fader et al. (U.S. Patent 5,736,486 - "Pappas-Fader") in view of Yasui et al. (JP 10330202 - "Yasui");

Claims 15, 20, 22 and 24 were rejected as allegedly being obvious under 35 U.S.C. §103(a) by Pappas-Fader et al. (U.S. Patent 5,736,486 - "Pappas-Fader") in view of Yasui et al. (JP 10330202 - "Yasui").

The applicants request reconsideration of these rejections for the following reasons.

A. Pappas-Fader and Yasui does not render claims 16-18, 21, 23, 25, 28 and 30-32 obvious

1. Pappas-Fader and Yasui do not teach or suggest all of the claim limitations of claims 16-18, 21, 23, 25, 28 and 30-32

Standard of Review

MPEP 2143.03 states in part that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." *In re Royka*, 490

F.2d 981, 180 USPQ 580 (CCPA 1974)". However, the combination of Pappas-Fader in view of Yasui does not teach or suggest all claim limitations.

Since the applicants filed their Appeal Brief on 12 March 2007, the U.S. Supreme Court issued their decision in *KSR International v. Teleflex. Inc.*, 550 U.S. ___, 127 S. Ct. 1727, 82 USPQ2d 1385, (2007) and the USPTO has issued their guidelines for determining obviousness in light of *KSR*. The applicants experience to date has been that the patent corps has interpreted *KSR* as making assertions of *prima facie* obviousness "easier" by lessening the evidentiary burdens required. However, *KSR* merely reaffirmed the use of the *Graham* analysis for obviousness, i.e. establishment of a *prima facie* case of obviousness was never limited to "teaching, suggestion, motivation" if the Office could show that the reason for combining the reference came from knowledge of those of ordinary skill in the art (usually a showing or assertion that the missing elements was so notoriously known in the art).

For the present application, *KSR* has no effect on the applicants' arguments against the holding of obviousness as the applicants have asserted that all limitations have not been taught and because there was no showing or knowledge in the art that the combination of elements would have yielded predictable results.

Turning our attention to the claims under examination, the appellants' claimed invention require: (1) a liquid formulation; (2) one or more compounds selected from the group consisting of a sulfosuccinate of the formula (I)..., gemini surfactants of formula (II); and gemini surfactants of formula (III); and (3) an ALS inhibitor in dissolved form. The Examiner appears to believe that the ALS inhibitor of Pappas-Feder is dissolved. *This is incorrect.* The ALS compound has not dissolved and no evidence has been provided to show this is an inherent property of Pappas-Fader or Yasui.

No evidence that Pappas-Fader or Yasui teaches that the ALS component is dissolved

The Examiner is arguing that the ALS is inherently dissolved in the referenced formulations. However, MPEP 2112, sec. IV (Requirements of Rejection Based on Inherency; Burden of Proof) states in part that "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).....To establish inherency, the *extrinsic evidence* 'must make clear that the missing

descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. ***Inherency, however, may not be established by probabilities or possibilities.*** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citations omitted)" - (emphasis added).

Moreover, this assertion of inherency is based on an incorrect interpretation of the term “solution”. On page 3, lines 1-2 of the 11 September 2006 Office Action, the Examiner stated that “...the ALS inhibitor(s) would inherently be dissolved since solution means ingredients therein are totally miscible.” *This is also incorrect.* A dictionary definition of ---solution--- is that it is “a single, homogeneous liquid, solid, or gas phase that is a mixture in which the components (liquid, gas, solid, ***or combinations thereof***) are uniformly distributed throughout the mixture.” (from *The McGraw-Hill Dictionary of Chemical Terms*, pg. 400 (1984)).

As such there is no reason to presuppose that the ALS inhibitor would be dissolved in the compositions of Pappas-Fader and there was no other evidence has been presented which supports the Examiner’s claim of inherency.

Yasui does not remedy any deficiencies with the Pappas-Fader reference as it is directed to an aqueous ***suspension*** (a mixture of fine non-settling particles of any ***solid*** within any liquid) wherein the solid material is the ***water-insoluble*** herbicide and therefore does not teach the herbicide compound in dissolved form. The appellants’ arguments with respect to inherency for Pappas-Fader also apply here.

2. Appellants provided evidence of secondary considerations which tend toward non-obviousness of their claimed invention

MPEP 2141 states that “Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C 103...the four factual inquiries enunciated therein as background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the art; and
- (D) Evaluating evidence of secondary considerations.”

In the present application, the appellants have provided evidence of secondary considerations within the specification. It is believed that this evidence provided the basis for the allowability of claim 29 (iodosulfuron).

As noted in MPEP 716.02, section I states “[t]he nonobviousness of a broader claimed range can be supported by evidence based on unexpected results from testing a narrower range if one of ordinary skill in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof. *In re Kollman*, 595 F.2d 48, 201 USPQ 193 (CCPA 1979).”

The table on page 38 not only showed evidence of unexpected stability for iodosulfuron, but also stability for foramsulfuron, mesosulfuron and combinations of iodosulfuron with fenoxaprop-ethyl and mefenpyr-ethyl. However, no evidence was presented in the final rejection which would contradict that a trend in the exemplified data would be supportive of a broader claim directed toward ALS inhibitors.

B. Pappas-Fader and Yasui does not render claims 15, 20, 22 and 24 obvious

1. Pappas-Fader and Yasui do not teach or suggest all of the claim limitations of claims 15, 20, 22 and 24 obvious

The arguments presented above with regard to claims 16-18, 21, 23, 25, 28 and 30-32 also apply to the rejection of claims 15, 20, 22 and 24.

2. Appellants provided evidence of secondary considerations which tend toward non-obviousness of their claimed invention

The arguments presented above with regard to claims 16-18, 21, 23, 25, 28 and 30-32 also apply to the rejection of claims 15, 20, 22 and 24.

3. Claims 15, 20, 22 and 24 are directed toward sulfonylureas as ALS inhibitors

The unexpected results with regard to the improvement of stability of an ALS inhibitor is even more surprising when taken in the context of sulfonylureas which are known in the art to be chemically unstable in solution. Claim 29 uses an iodosulfuron as the ALS inhibitor (a sulfonylurea) and evidence was also presented for foramsulfuron and mesosulfuron (also sulfonylureas) which showed unexpected stability of these sulfonylureas (see Table on page 38 in the specification, Examples I and II).

There is no reason or evidence presented in the rejection which establishes obviousness for sulfonylureas as a class of ALS inhibitors and as such at a minimum, these claims should also be allowed.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: Howard C. Lee
Marilyn M. Brogan Howard C. Lee
Reg. No. 31,233 Reg. No. 48,104
Telephone: (212) 588-0800
Facsimile: (212) 588-0500